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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/670,550
Filing Date: September 25, 2003
Appellant(s): SHAH, RAHUL L.

Robert C. Kowert
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 25, 2009 appealing from the Office action mailed April 13, 2009.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

| | | |
|---|------------------|---------|
| 7,337,210 | Barsness | 02-2008 |
| 2001/0025314 | Matsumoto et al. | 09-2001 |
| 2002/0152305 | Jackson et al. | 10-2002 |
| 2004/0030753 | Horvitz, Eric J. | 02-2004 |
| 2007/0061450 | Burnley et al. | 03-2007 |
| 2008/0092063 | Canfield et al. | 04-2008 |
| 2008/0104517 | Horvitz, Eric J. | 05-2008 |
| The American Heritage Dictionary of the English Language, Definition of "specific", 2000. | | |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 15, and 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 20, 27, 39, and 46 of copending Application No. 10/670849 ('849 hereinafter), in view of Horvitz, US Publication No. 2008/0104517 (Horvitz hereinafter).

| Instant Application Claim 1 | Copending application No. 10/670849 Claim 1 |
|---|--|
| A method comprising: detecting a computer system activity level indicative of activity of said computer system; | A method comprising: receiving an instant messaging operation directed to a given user, wherein said given user is not offline, and wherein said instant messaging operation is associated with a given presence state of an instant messenger; |
| determining whether said activity level exceeds an activity threshold in response to said detecting; and | determining a current presence state of said instant messenger in response to receiving said instant messaging operation, wherein <u>said current presence state corresponds to said given user</u> |
| | In response to determining that said given presence state matches said current presence state, processing said instant messaging operation. |
| | Claim 8 The method as recited in claim 1, further comprising: |
| transitioning a presence state specific to an instant messenger client to a busy state in response to determining that said activity level exceeds said activity threshold, wherein said presence state corresponds to a given user | <u>detecting a computer system activity level indicative of computer system activity</u> |
| | determining whether <u>said activity level exceeds an activity threshold in response to said detecting; and</u> |
| | <u>transitioning said current presence state of said instant messenger client to a busy state in response to determining that said activity level exceeds said activity threshold, wherein said presence state corresponds to a given user.</u> |
| | |

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 8 of the copending application disclose substantial features of claim 1 of the instant

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application except the feature of executing an instant messaging client on a computer system. However, Horvitz teaches the feature of executing an instant messaging client on a computer system (Paragraph 0096). It would have been too obvious to one of ordinary skill in the art to combine the copending application '849 with Horvitz to execute an instant messaging client on a computer system, which would enable real time communication between users and allowing communication based on preferences as suggested by Horvitz.

Claims 15 and 29 are rejected for the same reasons as claim 1. Claims 20, 27, 39, and 46 of the copending application '849, which comprise similar features of claims 1 and 8, disclose most of the features claims 15 and 29 of the instant application, and Horvitz teaches the feature of an instant messenger client executable on a computer system.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 15, and 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 11, 18, 21, and 28 of copending Application No. 10/670549 ('549 hereinafter), in view of Horvitz.

| Instant Application Claim 1 | Copending application No. 10/670549 Claim 8 |
|---|--|
| A method comprising: detecting a computer system activity level indicative of activity of said computer system; | The method as recited in claim 1, further comprising: |
| determining whether said activity level exceeds an activity threshold in response to said detecting; | <u>detecting a computer system activity level indicative of computer system activity</u> |
| | <u>determining whether said activity level exceeds an activity threshold in response to said detecting; and</u> |
| transitioning a presence state specific to said instant messenger client to a busy state in response to determining that said activity level exceeds said activity threshold, wherein said presence state corresponds to a given user | <u>transitioning a presence state of said instant messenger client to a busy state in response to determining that said activity level exceeds said activity threshold, wherein said presence state corresponds to a given user.</u> |

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Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 8 of the copending application '549 disclose substantial features of claim 1 of the instant application except the feature of executing an instant messaging client on a computer system. However, Horvitz teaches the feature of executing an instant messaging client on a computer system (Paragraph 0096). It would have been too obvious to one of ordinary skill in the art to combine the copending application '549 with Horvitz to execute an instant messaging client on a computer system, which would enable real time communication between users and allowing communication based on preferences as suggested by Horvitz.

Claims 15 and 29 are rejected for the same reasons as claim 1. Claims 11, 18, 21, and 28 of the copending application '549, which comprise similar features of claims 1 and 8, disclose most of the features claims 15 and 29 of the instant application, and Horvitz teaches the feature of an instant messenger client executable on a computer system.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, 8-9, 12, 15-17, 20, 22-23, 26, 29-31, 34, 36-37, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz, in view Jackson et al. US Publication No. 2002/0152305 (Jackson hereinafter).

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As per claim 1, Horvitz teaches substantially the invention as claimed including a method comprising:

executing an instant messenger client on a computer system (Paragraph 0069. Interface. Paragraph 0096. Computer modalities includes instant messaging.);

detecting a computer system activity level indicative of said computer system (Paragraphs 0063; 0091. Typing or using application.);

determining whether said activity level meets an activity threshold in response to said detecting (Paragraph 0063. Determine that context setting is true.); and

transitioning a presence state specific to said instant message client to a busy state in response to determining that said activity level meets said activity threshold, wherein said presence state corresponds to a given user (Paragraphs 0063; 0091. Employ Busy state based on activity.).

Horvitz teaches of determining whether an activity level meets an activity threshold but not specifically exceeding an activity threshold.

Jackson teaches of determining whether an activity level exceeds an activity threshold (Paragraph 0447; 0452. Monitor resource utilization that may include memory utilization, CPU utilization. Detect resource utilization exceeding a threshold.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to determine whether an activity level exceeds an activity threshold as taught by Jackson. The motivation for the suggested combination is that Jackson's teachings of determining whether an activity exceeds an activity threshold would allow a system to further define a user context while obtaining a similar result of using a condition of a computing system to define a state of busy.

As per claim 15, Horvitz teaches substantially the invention as claimed including a computer-accessible storage medium comprising:

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executing an instant messenger client on a computer system (Paragraph 0069. Interface. Paragraph 0096. Computer modalities includes instant messaging.);

detecting a computer system activity level indicative of said computer system (Paragraphs 0063; 0091. Typing or using application.);

determining whether said activity level meets an activity threshold in response to said detecting (Paragraph 0063. Determine that context setting is true.); and

transitioning a presence state specific to said instant message client to a busy state in response to determining that said activity level meets said activity threshold, wherein said presence state corresponds to a given user (Paragraphs 0063; 0091. Employ Busy state based on activity.).

Horvitz teaches of determining whether an activity level meets an activity threshold but not specifically exceeding an activity threshold.

Jackson teaches of determining whether an activity level exceeds an activity threshold (Paragraph 0447; 0452. Monitor resource utilization that may include memory utilization, CPU utilization. Detect resource utilization exceeding a threshold.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to determine whether an activity level exceeds an activity threshold as taught by Jackson. The motivation for the suggested combination is that Jackson's teachings of determining whether an activity exceeds an activity threshold would allow a system to further define a user context while obtaining a similar result of using a condition of a computing system to define a state of busy.

As per claim 29, Horvitz teaches substantially the invention as claimed including a system, comprising:

a computer system (Paragraphs 0093; 0096. Computer.); and

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an instant messenger client software module configured to execute on said computer system (Fig. 18-19. Paragraph 0069. Interface for setting IM preference.);

wherein said instant messenger software module is further configured to:

detect a computer system activity level indicative of activity of said computer system (Paragraphs 0063; 0091. Typing or using application.);

determining whether said activity level meets an activity threshold in response to said detection (Paragraph 0063. Determine that context setting is true.); and

transition a presence state specific to an instant messenger client to a busy state in response to said determination that said activity level meets said activity threshold, wherein said presence state corresponds to a given user (Paragraphs 0063; 0091. Employ Busy state based on activity.).

Horvitz teaches of determining whether an activity level meets an activity threshold but not specifically exceeding an activity threshold.

Jackson teaches of determining whether an activity level exceeds an activity threshold (Paragraph 0447; 0452. Monitor resource utilization that may include memory utilization, CPU utilization. Detect resource utilization exceeding a threshold.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to determine whether an activity level exceeds an activity threshold as taught by Jackson. The motivation for the suggested combination is that Jackson's teachings of determining whether an activity exceeds an activity threshold would allow a system to further define a user context while obtaining a similar result of using a condition of a computing system to define a state of busy.

As per claims 2, 16, and 30, Horvitz teaches the invention as recited in claims 1, 15, and 29 further teach comprising:

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determining whether said activity level does not meet said activity threshold subsequent to monitoring said presence state to said busy state (Paragraph 0063. Context setting is defined to be false, the context setting including activity.); and

transitioning said presence state of said instant messenger to an online state in response to determining that said level of computer system activity does not meet said activity threshold (Paragraph 0063. If context setting is true, then busy state is true. Paragraph 0097. Available, e.g. no longer busy.) .

Horvitz does not teach of determining whether said activity level does not meet said activity threshold but not specifically exceeding an activity threshold.

Jackson teaches of determining whether an activity level does not exceed an activity threshold (Paragraph 0447; 0452).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to determine whether an activity level does not exceed an activity threshold. The motivation for the suggested combination is that Jackson's teachings of determining whether an activity exceeds an activity threshold would obtain a similar and predictable result of using a condition of a computing system to further determine a state of busy.

As per claims 3, 17, and 31, Horvitz teaches the invention as recited in claims 1, 15, and 29 wherein said activity of said computer system comprises keyboard activity (fig. 46; Paragraph 0091. Typing.).

As per claim 6, 20, and 34, Horvitz does not specifically teach the invention as recited in claims 1, 15, and 29, wherein said activity of said computer system comprises processor utilization.

Jackson teaches monitoring system activity comprising of processor utilization (Paragraphs 0447; 0452).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the system activity to comprise processor utilization. The motivation for the suggested combination is that Jackson's teachings would provide an improvement to Horvitz's teachings by enabling setting of a busy state based on the activity level of Jackson and allowing a user to further define a state of busy.

As per claims 8, 22, and 36, Horvitz teaches the invention as recited in claims 1, 15, and 29, wherein said activity of said computer system is configurable by a user from a plurality of types of computer system activity (fig. 46-48; paragraph 0091. Select system activity.).

As per claims 9, 23, and 37, Horvitz teaches teach the invention as recited in claims 1, 15, and 29, wherein said activity threshold is configurable by a user (Paragraph 0063. Busy level is defined by one or more selected context setting.).

As per claims 12, 26, and 40, Horvitz teaches the method invention as recited in claims 1, 15, and 29, further comprising:

storing schedule information corresponding to a given user, wherein said schedule information is indicative of an activity status of said given user at a given time (Paragraph 0063. Calendar setting indicates status. Paragraph 0153. Calendar may include status and availability.);

querying said schedule information; and if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user (Paragraph 0063. Set

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state as Busy.).

Claims 4, 18, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz and Jackson, in view of Barsness, US Patent No. 7,337,210 (Barsness hereinafter).

As per claim 4, 18, and 32, Horvitz does not specifically teach the invention as recited in claims 1, 15, and 29, wherein said activity of said computer system comprises mouse activity.

Barsness teaches of detecting computer system activity comprising mouse activity (col. 11, lines 19-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the computer system activity as taught by Horvitz to comprise mouse activity as taught by Barsness. The motivation for the suggested combination is that Barsness' teachings would provide an improvement to the suggested system by expanding the detection of activity to include an additional input and thus allowing a user to further define a state of busy.

Claims 5, 19, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz and Jackson, in view of Canfield et al. US Publication No. 2008/0092063 (Canfield hereinafter).

As per claims 5, 19, and 33, Horvitz does not specifically teach the invention as recited in claims 1, 15, and 29, wherein said activity of said computer system comprises one or more simultaneous instant messenger sessions.

Canfield teaches of detecting computer system activity comprising one or more simultaneous instant messenger sessions (Paragraph 0049)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the computer system activity as taught by Horvitz to include one or more

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simultaneous instant messenger sessions. The motivation for the suggested combination is that Canfield's teachings would provide an improvement to the suggested system by expanding the detection of activity to include an additional detectable activity and thus allowing a user to further define a state of busy.

Claims 7, 21, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz and Jackson, in view Burnley et al. US Publication No. 2007/0061450 (Burnley hereinafter).

As per claims 7, 21, and 35, Horvitz does not specifically teach the method, computer-accessible storage medium, and the system as recited in claims 6, 20, and 34, wherein said processor utilization further comprises a foreground processor utilization corresponding to activity of foreground computer system processes and a background processor utilization corresponding to activity of background computer system processes, and wherein said activity threshold further comprises a foreground process threshold corresponding to said foreground processor utilization.

Burnley teaches a system for tracking and collecting utilization data, wherein the system tracks foreground processor utilization corresponding to activity of foreground computer system processes and a background processor utilization corresponding to activity of background computer system processes, and wherein said activity threshold further comprises a foreground process threshold corresponding to said foreground processor utilization (Paragraphs 0077-0078. Track each opened application and active processes. Paragraphs 0051; 0056. Determine when application is in focus and actively engaging in focused application.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for system to track foreground processor utilization corresponding to activity of foreground computer system processes and a background processor utilization corresponding to activity of background computer system processes, and wherein said activity threshold further comprises a

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foreground process threshold corresponding to said foreground processor utilization. The motivation for the suggested combination is that Burnley's teachings would provide an improvement to the suggested system by allowing determination of client activity to determine status based on different factors, including focused and unfocused application utilizations.

Claims 10, 24, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz and Jackson, in view of Matsumoto et al. US Publication No. 2001/0025314 (Matsumoto hereinafter).

As per claims 10, 24, and 38, Horvitz does not specifically teach the invention as recited in claims 1, 15, and 29, wherein said activity threshold further comprises a threshold time and wherein determining whether said computer system activity level exceeds an activity threshold further comprises determining whether a duration of said computer system activity level exceeds said threshold time.

Matsumoto teaches a system for determining presence state, wherein the system determines when active duration of a running application exceeds a predetermined time (Paragraph 0064).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the activity threshold to comprise a threshold time and to determine whether active duration of a running application exceeds a predetermined time. The motivation for the suggested combination is that Matsumoto's teachings would provide an improvement to the suggested system by providing an additional monitoring condition, which enables a user to further to define a state of busy.

Claims 11, 25, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz, Jackson, and Matsumoto, in view of Barsness.

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As per claims 11, 25, and 39, Horvitz does not specifically teach the invention as recited in claims 10, 24, and 38, wherein said threshold time is configurable by a user (col. 9, lines 50-59. Profile including activity time can be edited by user.).

Barness teaches of using a threshold time to set a user status, wherein the threshold time is configurable by a user (col. 9, lines 50-59. Profile including activity time can be edited by user.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the threshold time to be configurable by a user. The motivation for the suggested combination is that Barness' teachings would provide an improvement to the suggested system by providing an additional option to allow a user customize a state of busy.

Claims 13-14, 27-28, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz and Jackson, in view of Horvitz, US Publication No. 2004/0030753 (Horvitz '753 hereinafter).

As per claims 13, 27, and 41, the invention as recited in claims 1, 15, and 29, further comprising: receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining said presence state of said instant messenger in response to receiving said instant messaging operation; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining.

Horvitz '753 teaches of receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining said presence state of said instant messenger in response to receiving said instant messaging operation; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining (Paragraphs 0047; 0069. Queue message. Deliver message when user is free).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to receive an instant messaging operation directed to a given user, wherein said

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given user is not offline; determine said presence state of said instant messenger in response to receiving said instant messaging operation; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. The motivation for the suggested combination is that Horvitz '753's teachings would provide an improvement to the suggested by mitigated disruptiveness of messages as suggested by Horvitz '753.

As per claims 14, 28, and 42, Horvitz does not specifically teach the invention as recited in claims 1, 15, and 42, further comprising: storing an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to a given user; detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting.

Horvitz '753 teaches of storing an instant messaging operation associated with a given presence state of a instant messenger, wherein said given presence state corresponds to a given user; detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting (Paragraph 0047. During busy state, messages are queued. Message is not delivered until available free state).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to store an instant messaging operation associated with a given presence state of a instant messenger, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting. The motivation for the suggested combination is that Horvitz '753's teachings would provide an improvement to the suggested by mitigated disruptiveness of messages as suggested by Horvitz '753.

(10) Response to Argument

1) The double patenting rejection is necessarily provisional because the claims in the co-pending applications have not yet been patented. Nevertheless, Appellant respectfully traverses this rejection for at least the reason that the rejection's reliance on Horvitz is flawed as discussed in greater detail below with regard to the 103 rejection.

In response, Examiner respectfully disagrees that the rejection's reliance of Horvitz is flawed, which will further discussed below in response to arguments regarding the 103 rejection. The double patenting rejection is maintained.

2) While Horvitz discusses various types of context states including "busy levels", these context states are not presence states that are specific to an instant messenger client. They are defined only with respect to the contact manager system. The state stored by Horvitz's contact manager pertains to the state of these users. In Horvitz, instant messaging is merely a conduit of communication. Horvitz omits any specific discussion regarding the internal details of instant messaging.

In response, Examiner respectfully disagrees that the states as taught by Horvitz are not presence states that are specific to an instant messenger client. Applicant argues that Horvitz does not discuss the internal details of what the instant messenger is doing and that Horvitz omits any specific discussion regarding the internal details of instant messaging. It appears that Applicant considers the "presence state specific to said instant messenger client" as states generated by internal operations of the instant messenger client, i.e. instant messenger client's presence states.

However, the word "specific" in the claim does require the presence states to be generated or transitioned by internal operations of the instant messenger client. The claim does not require the presence states to be applicable only to the instant messenger client or for the presence state to be transitioned on the computer system executing the instant messenger. For instance, The American

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Heritage Dictionary of the English Language, 2000, (attached herewith) defines "specific" as "relating to, characterizing, or distinguishing a species" or "applying to on a particular thing". Thus, given the broadest reasonable interpretation, Examiner considers the "presence states specific to the instant messenger client" as presence states related to or applying to modes of communication, i.e. the instant messenger. Horvitz teaches of executing an instant messenger on a computer (Paragraph 0096) and transitioning to one or more states of busy-ness based on a level of activity (Paragraph 0063). The states determine whether messages are to be communicated through a method of communication including the instant messenger. A user can set communication options/preferences based on states (Paragraph 0076). For instance, if a user's state is available, messages can be communicated using the instant messenger. If the user's state is busy, messages are not communicated using the instant messenger client (figs. 19-20). Therefore, the presence states that are transitioned based on activity level are applicable to an instant messenger and are related to the instant messenger.

3) Claim 1 clearly states "executing an instant messenger client on a computer system". Both the instant messenger client and its state are distinct from Horvitz's users and their state. The instant messenger client required by claim 1 must be something being executed on a computer system, where as Horvitz's contactors and contactees are users of Horvitz's system. Horvitz's contact manager is not specific to an instant messenger client because the contact manager is generic to many modalities.

In response, Examiner does not consider "state specific to an instant messenger client" as the instant messenger client's states, i.e. states generated by internal operations of the instant messenger client. Horvitz teaches of executing an instant messenger client on a computer system (Paragraph 0096) and using the instant messenger as a preferred communication method. A user may define a preference for receiving communications by instant messenger based on states (Paragraph 0054, 0076). A current state determines whether or not the instant messenger is used as a communication method. The presence

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states are related to the instant messenger. Furthermore, Horvitz's contact manager maintains states and uses the states to determine a preferred method of communication, which includes the instant messenger, and sends the message according to the preferred method of communication. Thus, the contact manager is related to and concerned with the instant messenger.

4) Regarding claim 12, the cited reference fail to disclose " if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user" Horvitz does not disclose that the busy level state is based on the status of a correspondence between instant messenger presence state and schedule information.

In response, Examiner respectfully disagrees that Horvitz does not disclose the feature of claim 12. Examiner considers "presence state of said instant messenger" as presence state that is related to or applied to the instant messenger. Horvitz teaches of setting a state based on an activity in a calendar. A state is defined to be true or false by context settings. The calendar may indicate a context state, i.e. meeting, out of office. If a context state is true, then the defined state is true. For instance if Busy Level 2 is defined as in the Office in a calendar setting and the listed condition is true, then Busy Level 2 is true and the state of Busy Level 2 can be employed (Paragraph 0063). A defined setting in Horvitz's relates state with the instant messenger such that the instant messenger is or is not used as means of communication based on the state.

5) Regarding claim 4, Barsness cannot be properly combined with Horvitz and Jackson in the proposed manner to establish a prima facie case of obviousness. Applicant notes that according to Barsness "the reason for this check is that is presumed that very recent activity... is a very strong indicator

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that the user is available and should probably override any information.” It is a fundamental operating assumption of Barsness that activity indicates user availability. Claim 1 requires transitioning a presence state corresponding to a given user to a busy state.

In response, Horvitz teaches of transitioning a presence state corresponding to a given user to a busy state. Examiner is relying on Barsness merely to teach that detecting mouse activity to determine a state is known in the art. Furthermore, Barsness teaches "should" probably override but does not require overriding of information.

6) Appellant respectfully traverses the rejection of claims 5, 19, and 33 for at least the reasons given above with respect to the independent claims.

In response, Examiner maintains the rejection of claims 5, 19, and 33 for at least the above reasons that the independent claims are not patentable.

7) Appellant respectfully traverses the rejection of claims 7, 21, and 35 for at least the reasons given above with respect to the independent claims.

In response, Examiner maintains the rejection of claims 7, 21, and 35 for at least the above reasons that the independent claims are not patentable.

8) Appellant respectfully traverses the rejection of claims 10, 24, and 38 for at least the reasons given above with respect to the independent claims.

In response, Examiner maintains the rejection of claims 10, 24, and 38 for at least the above reasons that the independent claims are not patentable.

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9) Appellant respectfully traverses the rejection of claims 11, 25, and 39 and submits that Barness cannot permissibly be combined with remaining cited references for at least the reasons given above with respect to claim 4.

In response, Examiner maintains the rejection of claims 11, 25, and 39 for at least the above reasons that claim 4 is not patentable.

10) Regarding the rejection of claims 13 and 14, Examiner asserts Horvitz '753 as disclosing the features. Horvitz '753 attempts to determine whether or not a user is "busy" when determining whether to deliver a message. Nowhere does not this reference disclose that in making that determination, the presence state of the instant messenger is taken into account. Horvitz '753 does not disclose "detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting".

In response, Examiner respectfully disagrees that Horvitz does not take into account the presence state of the instant messenger. Horvitz '753 teaches of queuing and/or sending instant messages based on the busy state of the user (Paragraphs 0047, 0101). The busy state determines whether the instant message is to be sent to an instant messenger. While the busy state is related to a user, it is also related to the instant messenger. Therefore, a presence state related and applicable to the instant messenger is taken into account when queuing or sending a message.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

/JJ/ Joshua Joo

/NATHAN FLYNN/

Supervisory Patent Examiner, Art Unit 2454

Conferees:

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451

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